

REMARKS

Claim Rejections

Claims 1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43 stand rejected as obvious over U.S. Pat. No. 6,093,102 (Bennett '102) in view of U.S. Pat. No. 6,261,178 (Bennett '178), Admitted Prior Art, and U.S. Pat. No. 6,485,367 (Joshi).

Claims 4, 15, 36, and 44 stand rejected as obvious over Bennett '102 in view of Bennett '178, Admitted Prior Art, U.S. Pat. No. 6,231,442 (Mayerhoff), and Joshi.

Claims 10, 11, 21, and 22 stand rejected as obvious over Bennett '102 in view of Bennett '178, Admitted Prior Art, U.S. Pat. No. 6,001,016 (Walker), and Joshi.

Claim Amendments

Claim 1 has been amended to add additional features. Support for "...said controller being programmed to allow a person to select one or more options from a plurality of user-selectable options presented to said person, resulting in a set of one or more selected options and a set of one or more unselected options, said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to make an automated selection from said set of one or more unselected options after said person has selected one or more options, said controller being programmed to make an automated selection from said set of one or more unselected options in response to said request, after said person has selected one or more options, and according to the rules of said wagering game being played and according to a strategy to optimize the likelihood that said person will receive a value payout..." can be found in at least paragraph [0091] and Figure 18 of Applicant's specification as filed.

Claim 11 has been amended to correct minor grammatical mistakes.

Applicant respectfully submits that no new matter is believed to be added by way of these amendments.

The Cited References

Joshi teaches a self-learning gaming machine (Abstract) that is capable of recommending which symbol-bearing indicia to hold or discard during a main game. (Col. 2, lines 18-20).

Rule 131 Declaration Rejection

The Office Action rejected Applicant's submitted Rule 131 Declaration as being ineffective to overcome the Joshi reference because the evidence submitted was insufficient to establish a conception of the invention prior to the effective date of Joshi and to establish diligence from a date prior to the effective date of Joshi to a constructive reduction to practice of Applicant's invention.

With respect to conception, the Office Action states that "The attached exhibits...[are] silent [as] to...the utilization of game rules in making an automated selection according to the optimal strategy." (Sentence spanning pages 2-3). However, according to MPEP §715.07:

"An accompanying exhibit need not support all claimed limitations, provided that **any missing limitation is supported by the declaration itself**. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)." (emphasis added)

Applicant's declaration clearly supports the utilization of game rules in making an automated selection according to the optimal strategy (Beaulieu Declaration, ¶2); MPEP §715.07 makes it clear that Applicant's declaration with regard to this element is sufficient evidence of conception. The Examiner is also directed to Exhibit A, page 2, which also describes many aspects of Applicant's claimed invention. For example, this document states:

"...the player can choose to select bonus elements or choose to allow the gaming device to select such elements. Further, this feature builds on player perception that the gaming device has knowledge about and control over the outcome of games. The player may choose to let the machine select the bonus elements thinking that the device will select the elements representing the best possible outcome."

Accordingly, Applicant respectfully submits that the finding of insufficient evidence of conception was incorrect.

With respect to diligence, the Office Action states that "...there exists a 7 month period during which the written description of the invention was forwarded to the applicant's representative...that has not been accounted for." (Page 3, lines 12-15). However, proof of reasonable diligence does not require that the Applicant work constantly on the invention and drop all other work. Short gaps are permitted. Work on the invention every day is not necessary. Mycogen Plant Science, Inc. v. Monsanto Co., 252 F.3d 1306, 58 USPQ 2d 1891 (Fed. Cir. 2001). Accordingly, Applicant respectfully submits that the finding of insufficient evidence of diligence was also incorrect because short gaps are permitted and requests that the finding of insufficient diligence be withdrawn.

While Applicant believes that Joshi is not a valid prior art reference and respectfully requests withdrawal of rejections relying on Joshi, Applicant will address the substance of the Joshi rejections as well in the discussions below.

Applicant's Invention Recited by Claim 1 Would Not Have Been Obvious

The Office Action rejected claim 1 under 35 U.S.C. §103(a) as being obvious over Bennett '102 in view of Bennett '178, Admitted Prior Art, and Joshi. While the Office Action indicates that Bennett '102, Bennett '178, and the Admitted Prior Art do not teach “*the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout*”, the Office Action states that Joshi teaches this feature. Applicant respectfully disagrees with this interpretation of Joshi and notes that additional features have been added to claim 1 that are also untaught by the cited prior art.

Joshi teaches a self-learning gaming machine that can provide suggestions to players as to which player-selectable options should be selected for an optimal return. Applicant does not believe that Joshi teaches features of Applicant's amended claim 1, for instance, which are addressed below.

Applicant respectfully submits that Joshi does not teach a controller programmed to “...make an **automated selection from said set of one or more unselected options...after said person has selected one or more options...**” (Emphasis added). Joshi appears to only offer suggestions from the entire set of user-selectable options; it does not offer the ability for the gaming system to make an automated suggestion, let alone selection, from the set of one or more unselected user-selectable options after a person using the gaming system has selected one or more options. Applicant's claim 1, by contrast, recites a controller that is programmed to make automated selections from the set of one or more unselected options after...a person has selected one or more options.

The Office Action states that Joshi teaches an “optimized auto-selection feature”; Applicant respectfully disagrees with this characterization of Joshi. Applicant notes that Applicant's claim 1 recites that the controller is programmed to make an *automated selection* according to a strategy to optimize the likelihood that the player will receive a value payout. Joshi, by contrast, is only able to provide *suggestions* to a player as to which options to select. Joshi does not actually select anything. Applicant respectfully submits that Joshi actually teaches away from an automated selection capability, as noted in Applicant's response dated

December 30, 2008. The Examiner had indicated that Applicant's previous position that Joshi teaches away from an automated selection capability was not supported by "how Joshi and the...admitted prior art would teach away from each other". Applicant notes that at every opportunity where an automated selection capability could be implemented in Joshi, Joshi instead states that a "player may choose" the selection. The Examiner is referred to col. 4, lines 49-50; col. 4, lines 50-53; and col. 4, line 67, to col. 5, line 9 for examples of this. Given that Joshi consistently indicates that it is always the *player* who does the selecting, Applicant cannot see how it can be said that this does not teach away from the *gaming machine* doing the selecting.

Applicant respectfully submits that the cited art does not teach all elements of independent claim 1 because, at the least, none of the cited prior art either alone or in combination teaches "...said controller being programmed to allow a person to select one or more options from a plurality of user-selectable options presented to said person, **resulting in a set of one or more selected options and a set of one or more unselected options**, said controller being programmed to receive data relating to a request from said person made during said occurrence of said wagering game for said controller to **make an automated selection from said set of one or more unselected options after said person has selected one or more options**, said controller being programmed to make an automated selection from said set of one or more unselected options in response to said request, and according to the rules of said wagering game being played, after said person has selected one or more options, and according to a strategy to optimize the likelihood that said person will receive a value payout...". (Emphasis added). Because the cited art fails to teach all elements of claim 1, the rejection of claim 1 under 35 U.S.C. §103(a) is respectfully requested to be withdrawn.

Dependent claims 3, 4, and 7-11 include all of the features of claim 1 and, therefore, are patentable for at least the reasons discussed above.

Conclusion

In view of the forgoing, it is respectfully submitted that all of the claims are now in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested.

If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorney at (510) 663-1100.

The Commissioner is hereby authorized to charge any additional fees, including any extension fees, which may be required or credit any overpayment directly to the account of the undersigned, No. 504480 (Order No. IGT1P530).

Respectfully submitted,
Weaver Austin Villeneuve & Sampson LLP

/William J. Egan, III/

William J. Egan, III
Reg. No. 28,411

P.O. Box 70250
Oakland, CA 94612-0250
(510) 663-1100

/Christian D. Scholz/

Christian D. Scholz
Reg. No. 58,024